

## **REMARKS / ARGUMENTS**

### **A. Summary of the Amendments**

The present application still contains 46 claims.

The specification and the drawings have been amended in order to correct minor informalities detected by the Applicant upon review of the present application.

Claims 1-2, 5, 12-13, 16-17, 32-34 and 46 have been amended in order to clarify the subject matter being claimed in the application.

Claims 8, 13, 22, 26-28, 32, 40-41, 44 and 46 have been amended in order to correct minor informalities including typographical and grammatical errors that were detected by the Applicant.

Claims 12, 21, 23 and 32 have been amended in order to correct their claim dependencies.

The Applicant respectfully submits that no new subject matter has been added to the application by the present amendments.

### **B. Summary of Objections, Rejections and Reply**

#### **1) Rejection of claims 1, 16 and 33 under 35 USC 102**

In the Office Action, the Examiner has rejected claims 1, 16 and 33 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,991,742 (hereinafter referred

to as Tran). Applicant respectfully traverses this rejection and submits that claims 1, 16 and 33 are in allowable form for the reasons set forth below.

Independent claim 1

The Examiner's attention is directed to the following emphasized limitation of claim 1:

**"delivering information to the user from the computer prompting the user to provide to the computer information associated to the project but unrelated to billing-related information"**

Applicant respectfully submits that Tran does not disclose, teach or suggest the above-emphasized limitation of claim 1. Specifically, the cited reference neither teaches nor suggests "delivering information to the user from the computer prompting the user to provide to the computer information associated to the project but unrelated to billing-related information".

Tran describes a computer system for tracking and recording data associated with activities performed on behalf of a client by a service provider. The data entered into the computer system by the service provider includes billing-related information, which is eventually uploaded to an accounting system for billing purposes (see column 3, lines 8-11). To illustrate, as described in column 2, lines 26-30, 38-39 and 42-46 of Tran, the data entered by the service provider may include client identification, matter identification, billing rate, time spent on a project by the service provider, description of the activity being performed by the service provider and non-time related expenses and costs such as telephone calls, travel related expenses and goods necessary to carry out the activity in a project. All the aforementioned data contributes to the creation of a bill associated with a particular project for a client. It is respectfully submitted that the service provider is never prompted by the computer system to enter any data associated with a particular project which is not billing-related. More specifically, Tran does not address the possibility of "delivering information to the user from the computer prompting the user

to provide to the computer information associated to the project but unrelated to billing-related information".

On page 2 of the Office Action, the Examiner maintains that Figures 11 and 12 in the Tran reference teach the limitations of claim 1, including the limitation concerning providing information that is associated to a project but is unrelated to billing-related information. Applicant respectfully disagrees with the Examiner for the reasons that follow.

The time sheet in Figure 11 allows the service provider to track his or her billable hours by electronically logging in the amount of time spent working on a particular matter for a particular client; the expense sheet in Figure 12 allows the service provider to track expenses incurred by electronically entering the expense amount incurred in a particular matter for a particular client. It is generally known that a service provider will charge a client for both the amount of time spent working on a project and any expense incurred while working on the project (see column 1, lines 23-27). Thus, the purpose of filling out the time sheet and the expense sheet is clearly to track billing-related data, such that the information can be later used to bill client matters (see column 3, lines 8-11). It is therefore respectfully submitted that neither the time sheet in Figure 11, nor the expense sheet in Figure 12, teaches or suggests "delivering information to the user from the computer prompting the user to provide to the computer information associated to the project but unrelated to billing-related information".

In light of the foregoing, Applicant respectfully submits that Tran neither explicitly nor implicitly teaches all of the limitations of independent claim 1, such that the criteria for satisfying a rejection under 35 USC 102 have not been met<sup>1</sup>. Accordingly, Applicant respectfully submits that the subject matter of claim 1 is in allowable form and the Examiner is therefore respectfully requested to withdraw his

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<sup>1</sup> According to MPEP §706.02, 8<sup>th</sup> ed., in order for the Examiner to cite a rejection under U.S.C. 102, "The reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present."

rejection of claim 1.

Independent claim 16

The Examiner's attention is directed to the following emphasized limitation of claim 16:

**"a third program element component for causing the computer to display third information to the user, prompting the user to provide to the computer information associated to the project but unrelated to billing-related information."**

Claim 16 contains language similar to that of claim 1. Thus, for the same reasons set forth herein above in respect to claim 1, it is Applicant's respectful submission that independent claim 16 comprises at least one limitation missing from Tran, namely "a third program element component for causing the computer to display third information to the user, prompting the user to provide to the computer information associated to the project but unrelated to billing-related information".

In light of the foregoing, Applicant respectfully submits that Tran does not teach or suggest all of the limitations of independent claim 16, either explicitly or implicitly, such that the criteria for satisfying a rejection under 35 USC 102 have not been met. Accordingly, Applicant respectfully submits that the subject matter of claim 16 is in allowable form and, therefore, the Examiner is respectfully requested to withdraw his rejection of claim 16.

Independent claim 33

The Examiner's attention is directed to the following emphasized limitation of claim 33:

**"a third program element component for causing said computer to display third information to the user, prompting the user to provide to said computer information associated to the project but unrelated to billing-related information."**

Claim 33 contains language similar to that of claim 1. Thus, for the same reasons set forth herein above in respect to claim 1, it is Applicant's respectful submission that independent claim 33 comprises at least one limitation missing from Tran, namely "a third program element component for causing said computer to display third information to the user, prompting the user to provide to said computer information associated to the project but unrelated to billing-related information".

In light of the foregoing, Applicant respectfully submits that Tran does not teach or suggest all of the limitations of independent claim 33, either explicitly or implicitly, such that the criteria for satisfying a rejection under 35 USC 102 have not been met. Accordingly, Applicant respectfully submits that the subject matter of claim 33 is in allowable form and, therefore, the Examiner is respectfully requested to withdraw his rejection of claim 33.

## **2) Rejection of claims 2-15, 17-32 and 34-46 under 35 USC 103**

In the Office Action, the Examiner has rejected claims 2-15, 17-32 and 34-46 under 35 USC 103(a) as being unpatentable over Tran. As set forth herein below, Applicant respectfully traverses this rejection and submits that claims 2-15, 17-32 and 34-46 are in allowable form.

### **Dependent claims 2-15**

Claims 2-15 depend either directly or indirectly on claim 1 and therefore include all of the limitations of claim 1. As already set forth above with respect to claim 1, Tran does not teach or suggest the limitation of "delivering information to the user from the computer prompting the user to provide to the computer information associated to the project but unrelated to billing-related information".

The Examiner maintains on page 3 of the Office Action that the Tran reference teaches "generating a second message including [...] information associated to the project but unrelated to billing information" in column 10, line 16 to column 11, line 6. Applicant has carefully reviewed the passage cited by the Examiner and respectfully disagrees that Tran discloses, teaches or suggests a user providing, or a message including, information associated to the project but unrelated to billing-related information for the reasons provided herein below.

In the cited passage, Tran refers to Figures 2 and 3 as he describes the process for adding a new client to a database supporting the billing system and the process for adding a new matter for an existing client to the database.

A new client record is added to the database when the service provider has a new client or a potential client who is currently not in the database. As listed in column 10, lines 18-19, 32-34 and 47-52, information relating to the new client or the potential client includes contact data such as name, title, company and address, salutation, date started, industry, client status, referral source, special billing arrangement, client alphanumeric code, amounts associated with overdue bills, current billing amount, last bill date, client trust fund amount and replenishment level where the client is to be notified to update the retainer amount. Applicant wishes to underline the fact that the service provider entering information about a new client or potential client is completely distinct from the service provider actually having a project mandate from the client. Specifically, adding a new client record to the database in no way implies that the service provider has a project to complete for the new client. Firstly, a potential client clearly means that the service provider only has a potential lead such that a project may or may not be forthcoming. Secondly, if the service provider is adding a new client record, a matter file has yet to even be associated with the new client (see Figure 3). That is, at this particular stage, there is no project to speak of whatsoever. Hence, none of the client information in the cited passage can be, or should be, considered "information associated to the project but unrelated to billing-related information".

Following the creation of a new client, a new matter for an existing client may be added to the database. As described in column 11, lines 9-10, information relating to the new matter includes matter ID, matter description, date started and special billing arrangement. The collection of matter information is necessary in order to create a matter file for a particular client (see Figure 3). It is Applicant's respectful submission that there can be no project before the creation of a new matter. Hence, none of the matter information that is collected can be considered "information associated to the project but unrelated to billing-related information".

In light of the above and for the same reasons as those set forth herein above in respect of claim 1, it is respectfully submitted that at least one limitation of claim 1 is neither taught nor suggested by the cited art. Therefore, Applicant respectfully submits that there is at least one criterion, required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j), which is in this case not satisfied<sup>2</sup>.

Claims 2-15 depend directly on claim 1. Hence, for the same reasons as those set forth herein above in respect of claim 1, Applicant respectfully submits that claims 2-15 are in allowable form. The Examiner is therefore respectfully requested to withdraw his rejection of claims 2-15.

#### Dependent Claims 17-32

Claims 17-32 depend directly on claim 16 and therefore include all of the limitations of claim 16. As already set forth above with respect to claim 16, Tran does not teach or suggest the limitation of "a third program element component for causing the computer to display third information to the user, prompting the user to

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<sup>2</sup> For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

provide to the computer information associated to the project but unrelated to billing-related information".

Furthermore, for the same reasons as those set forth herein above in respect of claims 1-15, it is respectfully submitted that the passage cited by the Examiner on page 3 of the Office Action does not disclose, teach or suggest a user providing, or a message including, information associated to the project but unrelated to billing-related information.

In light of the above and for the same reasons as those set forth herein above in respect of claim 16, it is respectfully submitted that at least one limitation of claim 16 is neither taught nor suggested by the cited art. Therefore, Applicant respectfully submits that there is at least one criterion, required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j), which is in this case not satisfied.

Claims 17-32 depend directly on claim 16. Hence, for the same reasons as those set forth herein above in respect of claim 16, Applicant respectfully submits that claims 17-32 are in allowable form. The Examiner is therefore respectfully requested to withdraw his rejection of claims 17-32.

#### Dependent Claims 34-46

Claims 34-46 depend directly on claim 33 and therefore includes all of the limitations of claim 33. As already set forth above with respect to claim 33, Tran does not teach or suggest the limitation of "a third program element component for causing said computer to display third information to the user, prompting the user to provide to said computer information associated to the project but unrelated to billing-related information".

For the same reasons as those set forth herein above in respect of claims 1-15, it is respectfully submitted that the passage cited by the Examiner on page 3 of



the Office Action does not disclose, teach or suggest a user providing, or a message including, information associated to the project but unrelated to billing-related information.

In light of the above and for the same reasons as those set forth herein above in respect of claim 33, it is respectfully submitted that at least one limitation of claim 33 is neither taught nor suggested by the cited art. Therefore, Applicant respectfully submits that there is at least one criterion, required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j), which is in this case not satisfied.

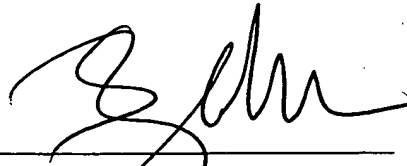
Claims 34-46 depend directly on claim 33. Hence, for the same reasons as those set forth herein above in respect of claim 33, Applicant respectfully submits that claims 34-46 are in allowable form. The Examiner is therefore respectfully requested to withdraw his rejection of claims 34-46.

### CONCLUSION

In view of the foregoing, Applicant is of the view that claims 1-46 are in allowable form. Favorable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the claims of the application are not considered to be in full condition for allowance, for any reason, Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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